

### **REMARKS**

Applicants have amended claim 140 to recite that the smooth, non-reticulating surface of the opposing electrode opposes the first electrode. This amendment is supported by the specification, for example, as shown in Fig. 3A, where reticulated anode 12 opposes non-reticulated cathode 14. Accordingly, no new matter has been added.

Claim 151 has been amended to recite that the first porous electrode has an average porosity of from about 10% to about 70%. New dependent claims 161 and 162 have been added, each depending from claim 151, reciting various average porosities of the first electrode. Support for these amendments can be found in the specification, for instance, on page 12, lines 28-30. Thus, no new matter has been added.

Claims 65-73, 76-88, 90-98 and 129-162 are now pending for examination. The Office Action of July 1, 2004 states that claims 74 and 75 are also pending; however, this believed to be a typographical error, as these claims had been previously canceled in a response filed March 2, 2004.

#### **Rejection of claims 65-88, 90-98 and 129-160 under 35 U.S.C. §112, ¶1**

Claims 65-88, 90-98 and 129-160 have been rejected under 35 U.S.C. §112, ¶1, as being non-enabling for “an article.” Claims 74 and 75 appear to have been inadvertently included in this rejection as a result of the above-described typographical error.

The term “article,” which appears only in the preamble of the claims and is therefore not an element of the claim, but only breathes “life and meaning” into the claim, generically refers to devices, mechanisms, apparatuses, etc. that include each and every element of each respective claim. Thus, as the term “article” is present only in a generic sense, and is nowhere recited as an actual element anywhere within the body of the claim, it is not seen how the term “article” renders the claims non-enabled. Applicants believe that the claims as described are fully enabling to those of ordinary skill in the art, and that the meaning of each claim would be understood by those of ordinary skill in the art.

The Examiner requests that the Applicants amend the rejected claims so as to be limited to a bipolar device, a battery, or a solid state energy device. The Applicants do not understand the basis for the Examiner’s suggestion that these *examples* of devices with which the invention can be used must therefore be lifted from the specification and inserted into the claims. The test

for enablement under 35 U.S.C. §112 is whether those of ordinary skill in the art are enabled, by the specification, to practice the invention as claimed, namely, electrode arrangements as recited in the rejected claims having various surface features, various positions relative to each other, etc. The recitation of the rejected claims is clear, and is clearly enabled by the specification. There is no justification for requiring that the claims be limited to specific devices which the specification sets forth as examples with which the invention can be used, where those of ordinary skill in the art would clearly recognize that the invention has applicability on a much wider scale.

Accordingly, it is respectfully requested that the rejection of claims 65-73, 76-88, 90-98 and 129-160 be withdrawn.

Rejection of claims 140-143 and 150-154 under 35 U.S.C. §102(e)

Claims 140-143 and 150-154 have been rejected under 35 U.S.C. §102(e) as being anticipated by Patel, *et al.*, U.S. Patent No. 6,342,317 ("Patel").

As an initial matter, Applicants do not concede that Patel is properly prior art to the Applicants' claimed inventions. Applicants reserve the right to establish an invention date for the claimed inventions that is on or before the effective date of Patel.

Regarding independent claim 140 as amended, it is not seen where in Patel is there a disclosure of an opposing electrode having a smooth, non-reticulating surface opposing the first electrode disclosed or suggested. In Patel, both electrodes are interpenetrating, for example, as shown in Fig. 2, with anode 14 and cathode 12, both of which include interpenetrating lobes. The Patent Office has not pointed to a disclosure or suggestion in Patel of a first electrode having a first surface that is reticulated, and an opposed electrode having an smooth, non-reticulated surface opposing the first electrode. Accordingly, it is respectfully requested that the rejection of independent claim 140 be withdrawn. Dependent claims 141-143 and 150 depend from independent claim 140, and are believed to be allowable for at least these reasons. Withdrawal of the rejection of these claims is thus respectfully requested.

With respect to independent claim 151 as amended, Applicants do not see where in Patel is there a disclosure or suggestion of an electrode having an average porosity of from about 10% to about 70%. In fact, nowhere does Patel suggest or disclose a porous electrode. Thus, it is believed that claim 151 distinguishes Patel, and it is respectfully requested that the rejection of

independent claim 151 be withdrawn. Dependent claims 152-154 depend from independent claim 151, and are believed to be allowable for at least the same reasons. Withdrawal of the rejection of these claims is also respectfully requested.

Rejection of claims 140-160 under 35 U.S.C. §102(b)

Claims 140-160 have been rejected under 35 U.S.C. §102(b) as being anticipated by Chen, U.S. Patent No. 5,677,080 ("Chen").

Regarding independent claim 140 as amended, it is not seen where in Chen is there a disclosure of an opposing electrode having a smooth, non-reticulating surface opposing the first electrode disclosed or suggested. In Chen, both electrodes are interpenetrating, for example, as shown in Figs. 5 and 5A, with anode 205 and cathode 215, both of which include interpenetrating lobes. The Patent Office has not pointed to a disclosure or suggestion in Chen of a first electrode having a first surface that is reticulated, and an opposed electrode having a smooth, non-reticulated surface opposing the first electrode. Accordingly, it is respectfully requested that the rejection of independent claim 140 be withdrawn. Dependent claims 141-150 depend from independent claim 140, and are believed to be allowable for at least the above-mentioned reasons. Thus, it is respectfully requested that the rejection of these claims be withdrawn.

With respect to independent claim 151 as amended, Applicants do not see where in Chen is there a disclosure or suggestion of an electrode having an average porosity of from about 10% to about 70%. Thus, it is believed that claim 151 distinguishes Chen, and it is respectfully requested that the rejection of independent claim 151 be withdrawn. Dependent claims 152-154 depend from independent claim 151, and are believed to be allowable for at least the same reasons. Withdrawal of the rejection of these claims is also respectfully requested.

**CONCLUSION**

In view of the foregoing remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the undersigned at the telephone number listed below.

Serial No.: 10/021,740  
Conf. No.: 1110

- 14 -

Art Unit: 1745

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,



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